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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LINDA L. HOFFBERG-BORGHESENI and
STEVEN M. HOFFBERG

Appeal 2010-002510
Application 09/497,071
Technology Center 2400

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ Our decision will make reference to the Appellant's Request for Rehearing (filed Jan. 3, 2012, "Request"), the BPAI Decision (mailed Oct. 31, 2011, "Decision"), and the Examiner's Answer (mailed Jan. 29, 2009 "Ans.").

STATEMENT OF THE CASE

Linda I. Hoffberg-Borghesani et al., (Appellants) filed a Request for Rehearing of the Decision affirming the rejection of claims 155-161 and 174 under 35 U.S.C. § 102(e) as being anticipated by Vogel.

In accordance with 37 C.F.R. § 41.52(a)(1), the Request includes certain points, in particular, that the Appellants believe the Board misapprehended or overlooked in reaching its Decision.

The Appellants believe that the Board misapprehended and overlooked their arguments directed to claim 155's step of "automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media, wherein said data representing content characteristics are not received as an input from a human user." *See* Request 2-13. We note that the Appellants' do not make separate arguments for dependent claims 156-161 and 154 and that all arguments are directed to claim 155.

We have reviewed the Request in its entirety but do not find that the Appellants have shown that the Board misapprehended or overlooked points in affirming the rejection of claim 7 under 35 U.S.C. § 103(a).

DISCUSSION

We are not persuaded by the Appellants' argument in the Request that the Board misapprehended or overlooked the Appellants' arguments related to the step of automatically performing a search recited in claim 155.

As we stated in our Decision, the Appellants' argument is not commensurate with scope of the claim 155. Decision 8-9.

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Claim 155’s limitation at issue is:

“automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media, wherein said data representing content characteristics are not received as an input from a human user.”

The Examiner found that the claimed “available media” to read on Vogel’s periodic data (*see* Vogel col. 3, ll. 49-59) and the claimed “data representing content characteristics of the previously selected media” to read on Vogel’s real-time data (*see* Vogel col. 3, ll. 59-66). Ans. 5.

The Examiner found (Ans. 6) and we agree, contrary to the Appellants’ argument (Request 5), that Vogel’s real-time data “are not received as an input from a human user.” Vogel states: “[Real-time] data is

transmitted from the remote source as soon as possible after a [change] of program on any channel.” Col. 3, ll. 62-64. *See also* col. 3, ll. 38-42 (“RF input 101 . . . comprises a signal modulated with data relating to the television schedule and the programs currently being broadcast.”) We note that this limitation does not require the data to never be input from human user, as the Appellants seem to argue, but more broadly to be *received* as input from a human user. The claim also does not define or restricted by what the data is received.

The Examiner also found that the real-time data represented “content characteristics of the previously selected media.” Ans. 6. We agree. Vogel states that the real-time data “comprises information which identifies which program is currently being broadcast on each channel, including the program classification.” Col. 3, ll. 59-62. Vogel describes the following as classifications:

- C: Suitable for Children
- G: General viewing
- A: Adult
- R: Restricted
- AD: Advertisement or other non-program material

Col. 4, ll. 45-51. Applying the Appellants’ own definitions of the terms content and characteristics (Request 6-10), we agree with the Examiner, that Vogel’s classifications such as “Adult” or “Suitable for Children” (col. 4, ll. 45-51) are content characteristics, as they indicate the quality (*see* Request 8) of the substantive information (*see* Request 6) of the program.

Further, notwithstanding that we agree with the Examiner that Vogel actually describes the claimed “data representing content characteristics of previously of the previously selected media,” we note that the claimed data

is clearly information, albeit the information is specifically characterized as representing content characteristics of previously of the previously selected media. There is no evidence sufficient to show that the structure of the information, i.e., the data, is functionally affected by it, specifically, representing content characteristics of previously of the previously selected media. Absent such evidence, it was reasonable to conclude that the representing content characteristics of previously of the previously selected media aspect of the information is descriptive and not functionally related to any structure of the claimed invention and as such fell under the category of patentably inconsequential subject matter. The fact that the claim requires associating an identifier with *non-personally identifiable demographic data pertaining to the user* does not change the fact that the identifier is associated with data but that aspect of the data which is to be a user's non-personally identifiable demographic information is properly considered to be nonfunctional and descriptive. See *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) ("Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to

be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.).” See also *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative).

Finally, the Examiner found (Ans. 6) and we agree, contrary to the Appellants’ argument (Request 2-13), that Vogel teaches automatically performing a search of [the periodic data] for a correspondence to [the real-time data].

Initially, we note that the Specification does not contain lexicographic definitions of “correspondence.” A definition of correspondence is “a particular similarity.” *Merriam-Webster’s Collegiate Dictionary* 260 (10th Ed. 1998.) Therefore, when given the broadest reasonable interpretation in light of the Specification, this limitation requires automatically performing a search of Vogel’s periodic data for a particular similarity to Vogel’s real-time data. We note that the limitation does not restrict how the search for the correspondence is performed, other than it is automatic. Further, the limitation does not require that the search determine a correspondence, but merely that it is “for” a correspondence. The limitation does not require that the search be done by “analyz[ing] the actual content of the media,” (Request 4) or that the search be done by matching the content characteristics of the available media to the claimed data (Request 12), as the Appellants seem to argue.

The Examiner found (Ans.6) that this limitation read on Vogel’s initiation of “the program menu,” which displays the classification (Fig. 3), and that the classification is also part of the real-time data (i.e. a particular similarity with the periodic data). Ans. 6.

Vogel states:

On receipt of program schedule data, microprocessor 104 stores the data in random access memory RAM 106.

On receipt of a command from the user requesting information, such as the program schedule, *microprocessor 104 retrieves the relevant data from RAM 106*, formats it for display and stores it in text random access memory TRAM 108.

Text generator 109 accesses the data stored in TRAM 108 and generates a video raster signal which when conveyed to a television receiver via RF modulator 110 and RF output 111 causes the text to be displayed on the screen of video appliance 114 which may be a television receiver or receiver/recorder.

Col. 3, l. 67 – col. 4, l. 11 (emphasis added). Vogel's Figure 3 depicts the displayed program schedule (col. 3, ll. 12-13), which displays the time of broadcast, the title and classification. In order to display the classification (i.e., the particularly similarity), Vogel's microprocessor 104 would have to retrieve (i.e., search) the classification from the program schedule data (i.e., the available media data).

As we stated in our Decision (Decision 8-9), the Appellants' argument are not commensurate with the scope of this limitation.

CONCLUSION

We have carefully considered the arguments that the Appellants have set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to our affirmance of claims 155-161 and 174 under 35 U.S.C. § 102(e) as being anticipated by Vogel.

DENIED

JRG